

### **REMARKS**

Applicants thank the Examiner for the thorough examination given the present application.

#### **Status of the Claims**

Claims 2-6, 8, and 11-12 will be pending in the above-identified application upon entry of the present amendment. Claims 1, 7, and 9-10 are cancelled herein. Claims 2-4, 8, and 11 have been amended to depend from claim 6. Claims 6 and 12 have also been amended. Support for the recitations in claim 6 can be found in the present specification, *inter alia*, at paragraphs [0020], [0023], and [0028] and Figures 3-4. Support for the recitations in claim 12 can be found in the present specification, *inter alia*, at paragraphs [0020], [0022]-[0023], and [0028] and Figures 3-4. Thus, no new matter has been added. Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

#### **Claim Objections**

Claim 12 is objected to because the Examiner suggests replacing “the absorbent cluster” with “the absorbent clusters.” Claim 12 has been amended herein to overcome this issue. As such, Applicants respectfully request that this objection be withdrawn.

#### **Issues over the Cited References**

Claims 1-6 and 9-12 are rejected under 35 U.S.C. § 102(b) as being anticipated by **Dean ‘453** (US 4,822,453).

Claims 1-2, 4-5, and 7-9 are rejected under 35 U.S.C. § 102(e) as being anticipated by **Tsuchiya ‘696** (EP 1142696).

Claim 8 is rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over **Dean ‘453**.

Applicants respectfully traverse. Reconsideration and withdrawal of these rejections are respectfully requested based on the following considerations.

Legal Standard for Determining Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Legal Standard for Determining Prima Facie Obviousness

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

*Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Exemplary rationales that may support a conclusion of obviousness include:

- (a) combining prior art elements according to known methods to yield predictable results;
- (b) simple substitution of one known element for another to obtain predictable results;

(c) use of known technique to improve similar devices (methods, or products) in the same way;

(d) applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(e) “obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success

(f) known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

(g) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. *See* MPEP 2143.03.

*Distinctions over the Cited References*

The pending claims are directed to independent claims 6 and 12. Since these claims are not included in the second prior art rejection above, this rejection is now rendered moot.

With respect to the remaining rejections, claims 6 and 12 recite that “the small clusters have an average size of 0.2 to 5 mm.” This limitation is the subject matter of claim 7, which was not included in the first and third prior art rejections. As such, **Dean ‘453** fails to disclose each and every element of the pending claims.

Furthermore, claims 6 and 12 recite that “the extensible absorbent member has a fiber density around the small absorbent clusters that is higher than a fiber density around an area of support surrounding the small absorbent clusters.” The cited references also fail to disclose this feature.

Accordingly, the present invention is not anticipated by **Dean ‘453** or **Tsuchiya ‘696** since the references do not teach or provide for each of the limitations recited in the pending claims.

Moreover, a *prima facie* case of obviousness has not been established. To establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be

disclosed by the cited references. As discussed above, **Dean '453** fails to disclose all of the claim limitations of independent claims 6 and 12, and those claims dependent thereon. Accordingly, the reference does not render the present invention obvious.

Furthermore, the cited reference or the knowledge in the art provides no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Therefore, withdrawal of the outstanding rejection is respectfully requested. Any contentions of the USPTO to the contrary must be reconsidered at present.

**Conclusion**

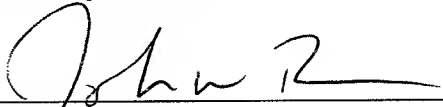
All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Registration No. 58,258, at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

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Respectfully submitted,

By 

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